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TC 2000 MAIL ROOM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

NAOKI ENOMOTO, ET AL.

Application No.: 09/327,167

Filed: June 7, 1999

For: IMAGE FORMING APPARATUS ) March 15, 2001

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: Examiner: Q. Grainger

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: Group Art Unit: 2852

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Office of Petitions  
The Commissioner for Patents  
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OFFICE OF PETITIONS

PETITION UNDER 37 C.F.R. § 1.181  
TO WITHDRAW NOTICE OF ABANDONMENT

Sir:

Applicants respectfully request the Assistant Commissioner for Patents to restore the above-identified abandoned application to pending status on grounds that Applicants were advised by the Examiner that a new Office Action was being issued and, while awaiting receipt of that new Office Action in reliance on the representations of the Examiner, the above-identified application went abandoned, the Examiner neglecting to issue the new Office Action as promised.

### FACTS

1. Applicants are in receipt of a Notice of Abandonment, mailed March 2, 2001 (copy enclosed as Exhibit A), indicating that the subject application was abandoned by Applicants failure to respond to the Office Action mailed on June 23, 2000.

2. Applicants received the Office Action mailed June 23, 2000 on or about June 28, 2000. A copy is attached as Exhibit B.

3. In the June 23, 2000 Office Action, the Examiner rejected Claims 1-3, 14, 16-27, 29-30 and 36-45 under 35 U.S.C. § 102(b) as being anticipated by Schlueter, Jr., et al. However, the Office Action did not identify Schlueter, Jr., et al., did not include a copy of Schlueter, Jr., et al., and did not have attached thereto a form PTO-892 identifying that reference. Thus, when Applicants began working on a response within the extended time period for response, they were unable to address the prior art issues concerning Schlueter, Jr., et al.

4. The failure to identify Schlueter, Jr., et al. was contrary to MPEP § 707.05 and 37 C.F.R. § 1.104(d)(1). 37 C.F.R. § 1.104(d)(1) states:

"If domestic patents are cited by the examiner, their numbers and dates, and the name of the patentees must be stated."  
(emphasis added)

The June 23, 2000, Official Action (Exhibit B) did not identify the patent number or date of Schlueter, Jr., et al. and it is not possible to determine from the Official Action the particular prior art reference intended by the Examiner.

5. Promptly after becoming aware that Schlueter, Jr., et al. was not identified with a patent number or other identified designation, Applicants' representative telephoned the Examiner, Examiner Grainger, on December 20, 2000, to ask for a more specific identification of the Schlueter, Jr., et al. reference.

6. In the December 20, 2000, telephone conversation between Applicants' representative and Examiner Grainger, Examiner Grainger advised Applicants' representative that Schlueter, Jr., et al. was a U.S. patent and bore U.S. Patent No. 6,042,917. Examiner Grainger also told Applicants' representative that she would restart the outstanding Official Action and that it was therefore unnecessary to respond to the June 23, 2000 Official Action. Applicants' representative requested written

confirmation by way of an Interview Summary form, but Examiner Grainger indicated it was not necessary.

7. On January 22, 2001, after Applicants had still not received the reissued Official Action, Applicants' representative again contacted Examiner Grainger to determine the status of the promised restart of the June 23, 2000 Official Action. Examiner Grainger advised Applicants' representative in that telephone conversation that no action had yet been taken in the above case but that she would send out an action that day restarting the date for response to the outstanding Official Action.

9. Applicants never received the reissued Office Action that twice had been promised by the Examiner. Instead, Applicants received the Notice of Abandonment attached as Exhibit A.

#### RELIEF REQUESTED

The Assistant Commissioner is respectfully requested to restore the above-identified abandoned application to pending status since Applicants' failure to respond to the outstanding Official Action was a result of the Examiner's failure to comply with the requirements of MPEP § 707.05 and 37 C.F.R. § 1.104, and

was compounded by Examiner Grainger's assurance to Applicants' representative that Applicants need not respond to the original Official Action because the Examiner was restarting the time for response by issuance of a new Official Action. It is respectfully requested that the application be returned to the Examiner with instructions to Reissue the outstanding Official Action.

FEE

The Assistant Commissioner is hereby authorized to charge Deposit Account No. 06-1205 for any petition fee which may be due. However, since it is believed that the holding of abandonment is a result of circumstances not attributable to any fault of Applicants or their representatives, it is respectfully suggested that no fee is due.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our address given below.

Respectfully submitted,



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